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1 UNITED STATES PATENT AND TRADEMARK OFFICE
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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* KEVIN J. ZILKA and
9 DOMINIC M. KOTAB
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12 Appeal 2009-007307
13 Application 10/661,878
14 Technology Center 3600
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17 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
18 ANTON W. FETTING, *Administrative Patent Judges*.
19 FETTING, *Administrative Patent Judge*.

20 DECISION ON APPEAL¹
21

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE²

Kevin J. Zilka and Dominic M. Kotab (Appellants) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1, 2, 4-13, 18-20, 44, and 45, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a patent management tool (Specification 1:16-17). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A computer program product embodied on a computer readable medium for organizing patents utilizing a computer-implemented system, comprising:

[1] computer code for displaying a notes field

for receiving manually entered notes including text;

[2] computer code for receiving the manually entered notes, utilizing the notes field;

[3] computer code for storing the manually entered notes in association with at least one identifier,

² Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed May 27, 2008) and Reply Brief ("Reply Br.," filed August 25, 2008), and the Examiner's Answer ("Ans.," mailed August 25, 2008).

1 thus associating the manually entered notes with the at
2 least one identifier;
3 [4] computer code for receiving the manual selection of a file;
4 [5] computer code for storing the manually selected file in
5 association with the at least one identifier
6 by providing a correspondence between the file and the at
7 least one identifier,
8 thus associating the manually selected file with the at
9 least one identifier, wherein
10 a manually selected first file is associated with a
11 first identifier corresponding to a single patent, and
12 a manually selected second file is associated with a
13 second identifier corresponding to a group
14 involving a plurality of patents; and
15 [6] computer code for associating a plurality of patents with the
16 at least one identifier;
17 [7] wherein
18 the manually entered notes,
19 at least one of the manually selected files, and
20 the patents
21 are accessible by subsequent selection of the at least one
22 identifier;
23 [8] wherein a set of the patents is reported using
24 [8a] computer code for displaying a technology mapping
25 depicting a plurality of categories of technology
26 utilizing a graphical user interface,
27 [8b] computer code for displaying statistics
28 regarding a number of the patents of the set in each
29 of the categories of technology in a first interface,
30 [8c] computer code for displaying
31 first additional information associated with at least
32 a portion of the patents of the set

1 in a second interface separate from the first
2 interface
3 upon the selection of an icon
4 positioned in the first interface and
5 associated with one of the statistics,
6 for drilling down from the first interface to the
7 second interface,
8 wherein the first additional information includes
9 a list of the patents of the set associated with
10 one of the categories of technology,
11 [8d] computer code for displaying
12 second additional information associated with at
13 least one of the patents of the list
14 in a third interface separate from the first interface
15 and the second interface
16 upon the selection of an additional icon
17 positioned in the second interface and
18 associated with one of the patents,
19 for drilling down from the second interface to the
20 third interface,
21 wherein the second additional information includes
22 at least one of
23 a patent number,
24 a status,
25 an exemplary claim, and
26 an exemplary figure;
27 [9] wherein the notes and at least one of the files
28 are made accessible to other parties utilizing e-mail.

The Examiner relies upon the following prior art:

Rivette	US 2003/0046307 A1	Mar. 6, 2003
Barnett	US 2002/0082778 A1	Jun. 27, 2002

Claims 1, 2, 4-13, 18-20, 44, and 45 stand rejected under 35 U.S.C.

§ 112, first paragraph, as lacking a supporting written description within the original disclosure.

Claims 1, 2, 4-13, 18-20, 44, and 45 stand rejected under 35 U.S.C.

§ 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

Claims 1, 2, 4-13, 18-20, 44, and 45 stand rejected under 35 U.S.C.

§ 103(a) as unpatentable over Rivette and Barnett.

ISSUES

The issues are whether the references to interfaces in the claims are adequately supported in the Specification, whether numerous claim limitations that the Examiner requested clarification on are indefinite, whether the computer code in claim 20 is actually on the computer readable media and whether such computer readable media encompasses non-statutory embodiments, and whether an icon that causes further display of data is non-functional descriptive material.

We AFFIRM-IN-PART.

FACTS PERTINENT TO THE ISSUES

Facts Related to the Prior Art

Rivette

01. Rivette is directed to tools for patent-centric and group oriented data processing. Rivette ¶ 0003.

Barnett

02. Barnett is directed to an analytical process and tools for assisting in making strategic and tactical business decisions. Barnett ¶ 0002.

ANALYSIS

Claims 1, 2, 4-13, 18-20, 44, and 45 rejected under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure.

Limitation [8] of claim 1 refers to several interfaces. The Examiner found that the original claims did not use the word “interface” and at most the Specification showed that one may be allowed to select a summary icon on the GUI, and such icon may act as a link to another page which sets forth additional information and that the summary report lists each of the intellectual property identifiers, each competing patent, etc. and that each item in the lists may include links to an additional page. The Examiner also found that the Specification discloses that upon a user selecting one of the intellectual property identifiers, more information relating to the property may be presented. At most, an additional page or information is presented.

1 The Examiner found no disclosure that the page is separate for the first of
2 second information. The Examiner also found that a page is not another
3 interface or GUI. Ans. 3-7.

4 The Appellants provided citations to the Specification for such support.
5 Appeal Br. 18-23; Reply Br. 2-20. Accordingly the issue is whether the
6 original disclosure supports the use of the word “interface” in limitation [8]
7 of claim 1 and similar limitations in the other claims.

8 In particular, the Appellants cited Specification 29:22-24, 32:8-25, and
9 33:6-14, and cite to Figs. 13, 15, and 16. Appeal Br. 17. These portions
10 describe electronic versions of reports that are displayed on screens. Thus,
11 such reports display information from the system. Also, they describe
12 accepting input in the form of link selection to display selected further
13 information. Thus, these portions refer to portions of an electronic display
14 that both provide data to a user and accept data from a user. We agree with
15 the Appellants that one of ordinary skill would consider such structural
16 portions of the display as interfaces.

17 *Claims 1, 2, 4-13, 18-20, 44, and 45 rejected under 35 U.S.C. § 112, second*
18 *paragraph, as failing to particularly point out and distinctly claim the*
19 *invention.*

20 The test for indefiniteness is whether one of ordinary skill would have
21 found the claims indefinite. The Examiner posed a series of questions as to
22 how the claims are to be construed, but made no showing that one of
23 ordinary skill would have been unable to understand the metes and bounds
24 of the claims. Ans. 7-13; 24-28.

1 While we would generally agree that the practice of having the
2 Applicants clarify what might be obscure language, having done so, the
3 Examiner must show why one of ordinary skill would have found the
4 remaining portions indefinite. The Appellants provided clarification at
5 Appeal Br. 25-31 and Reply Br. 20. In particular, the Appellants responded
6 that the ordinary meaning as might be found in a dictionary is to be used for
7 construction, and that while some of the terms are broad, breadth itself is not
8 indefiniteness.

9 We agree that the Examiner's requests for clarification have been
10 adequately responded to and that the Examiner has not shown that the claims
11 would be indefinite to one of ordinary skill.

12 The Examiner separately rejected claim 20 because the preamble recites
13 that the claims is directed to a system and the Examiner did not understand
14 which of the enumerated categories of statutory subject matter the claim fell
15 within. Ans. 13. In particular, the body of the claim recites a computer
16 readable medium and separately recites each of several computer codes for
17 performing functions. Thus, one of ordinary skill could not determine
18 whether the computer codes are embedded on the computer readable
19 medium. Further, the Examiner found that not all computer readable media
20 are statutory. Thus, the Examiner found that one of ordinary skill could not
21 determine whether the claim was directed toward statutory subject matter.
22 The Appellants respond that the system comprises computer readable media
23 and the Specification describes tangible versions. Appeal Br. 33. This does
24 not resolve the issues the Examiner found, and so we find this argument by
25 the Appellants unpersuasive.

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2 *Claims 1, 2, 4-13, 18-20, 44, and 45 rejected under 35 U.S.C. § 103(a) as*
3 *unpatentable over Rivette and Barnett.*

4 Each of independent claims 1, 18-20, 44, and 45 recite a system for
5 associating a patent with notes and groups of patents and techniques for
6 analyzing the patents. Generally, so does Rivette. Each of these claims
7 recites at least one particular technique in common, and this particular
8 limitation is dispositive. In exemplary claim 1, the limitation at issue is [8c],
9 reciting that additional information is displayed in another interface upon the
10 selection of an icon. Limitation [8d] has a similar display upon icon
11 selection. The Appellants argue that neither reference describes this.
12 Appeal Br. 36.

13 The Examiner did not find otherwise. Instead, the Examiner found it
14 was to be given no patentable weight as non-functional descriptive material.
15 The Examiner found that

16 [j]ust because one selects an icon to display more data does not
17 automatically render that data as functional. That argument is
18 not persuasive. With respect to the actual data displayed, it is
19 still seen as being directed to non-functional descriptive
20 material as it is just descriptive in nature and merely describes
21 certain patent information. The data stored and displayed by the
22 system is merely stored and retrieved and this does not present
23 a functional relationship between the system and what is
24 displayed.

25 Ans. 31. While we agree that the data that is displayed is non-functional
26 descriptive material, an icon that is attached to code that causes display of
27 information when selected is functional. Perhaps the icon itself is just a
28 display, but the claim clearly recites that there is code that causes a

functional change in processing when that icon is selected. The Examiner has not pointed to any portion of either reference to describe that limitation.

CONCLUSIONS OF LAW

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 2, 4-13, 18-20, 44, and 45 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 2, 4-13, 18-19, 44, and 45 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claim 20 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

The Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1, 2, 4-13, 18-20, 44, and 45 under 35 U.S.C. § 103(a) as unpatentable over Rivette and Barnett.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1, 2, 4-13, 18-20, 44, and 45 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure is not sustained.

